

REMARKS

In the outstanding office action, Claims 4 and 8 stand rejected under 35 USC 112, second paragraph, as being indefinite. The specification stands objected to as lacking a serial number and filing date for a referenced application, Claims 17-22 stand objected to, Claims 1-2 stand rejected under 35 USC 102 as being anticipated by Howland et al. ("Howland"), and Claims 1, 4, 6, 7-12-28, 32-33 and 35-37 stand rejected under 35 USC 103 as being unpatentable over Hardwick et al. ("Hardwick") in view of Howland and Chatwin et al. ("Chatwin").

Applicants note that Claims 15-28 and 29-31 were previously withdrawn as being directed to non-elected inventions, in the office action mailed December 12, 2001. Applicants assume that the restriction requirement as to Claims 15-28 has been withdrawn, since the outstanding office action has examined these claims on the merits.

Claims Rejections - 35 USC 112, Second Paragraph

The rejections of Claims 4 and 8 have been addressed by appropriate amendment of these claims.

Objections To The Specification

The specification has been amended to reflect the serial number and filing date of the referenced patent application.

Claim Objections

Claims 17-22 stand objected to on the grounds that it is unclear what "interference preventing means" means. This objection is respectfully traversed, on the ground that "interference preventing means" corresponds to the "means

for preventing interference" of Claim 17, and there is no showing why one of ordinary skill would not understand its meaning. However, Claims 17, 19, 20, 21 and 22 have been amended for the sole purpose of addressing this objection.

Claims Rejections -35 USC 102

Claims 1 and 2 stand rejected as being anticipated by Howland. This ground of rejection is respectfully traversed on the grounds that a prima facie case of anticipation has not been established, and the reference does not teach each element of the rejected claims.

Claim 1 includes the limitation:

means for preventing interference between a first fluorescing signal emitted by the first indicia and a second fluorescing signal emitted by the second indicia during a detection process for reading information from said first indicia or said second indicia, said means including a reflective layer structure positioned between the first indicia and the second indicia, said reflective layer preventing passage of said first fluorescing signal and said second fluorescing signal during said detection process.

Howland does not describe the foregoing limitation. The Examiner asserts that Howland describes that the substrate can be coated with a very thin layer of aluminum (equivalent to the thin metal foil layer of claim2), metal oxide or other reflective layer at col. 3, lines 23-33, and that the structure has a means for preventing interference is inherent as the same layered structure and materials are provided by Howland. Applicants respectfully disagree.

Howland describes that the patch 10 allows both the first and second indicia to be viewed under transmission conditions (7:62-64), and that a metallization is done in such a manner as to maintain sufficient light transmission (8:5-7). Such light or energy transmission may well lead to interference between the first and second indicia.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. The missing element or function must necessarily result from the prior art reference. MPEP 2112. Because Howland does not describe expressly the missing limitation, and such limitation does not necessarily result from Howland, a prima facie case of anticipation has not been established.

The rejection under Section 102 should be withdrawn.

Claims Rejections - 35 USC 103

Claims 1, 4, 7-12-28, 32-33 and 35-37 stand rejected as being unpatentable over Hardwick in view of Howland and Chatwin. This rejection is respectfully traversed on the grounds that a prima facie case of obviousness has not been established, and the applied references do not teach or suggest the claimed invention.

Applicants respectfully disagree with the recitation of the teachings of the references set out in the office action.

Hardwick is directed to banknote security devices, wherein inks are applied above and below a substrate. As the Examiner recognizes, Hardwick does not describe placing a reflective layer between the two ink indicia.

Howland is cited as allegedly showing a security device with first and second indicia with a metallized substrate in the middle, the substrate coated with a very thin film of aluminum (equivalent to thin metal foil layer of claim 2), metal oxide or other reflective layer at col. 3, lines 23-33. This teaching of Howland has been addressed above regarding the Section 102 rejection. There is no teaching or suggestion in Howland that the security device include a means for preventing interference as recited in Claims 1 and 15. For this reason alone, a prima facie case of obviousness has not been established.

The Examiner further alleges that it would have been obvious to modify the banknote of Hardwick to include a metallized foil, or reflective layer as the substrate since Howland teaches metallizing a substrate to exhibit such

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properties as high reflectivity and also enable the second indicia to be viewed in transmitted light. Applicants respectfully disagree. There is no showing of any advantage to be achieved by adding the very thin metal layer of Howland to Hardwick. Moreover, even if the combination is made as urged by the Examiner, the claimed invention still does not result since the modified Hardwick device would not include a "means for preventing interference" as set out in the rejected claims.

Chatwin is cited as showing a polyester material for the substrate. Because the reference does not add the missing limitation of a "means for preventing interference" the combination of references fails to provide a prima facie case of obviousness.

Insofar as Chatwin is understood, none of the examples describe first and second indicia defined by a fluorescent material as recited in the claims, nor a means for preventing interference as recited in Claims 1 and 15. Chatwin describes that a bank note thread can have miniature holographic areas subtly overprinted with indicia receptive coating presented with or containing as windows defining fine security indicia, and that "both sides of the thread may be embossed, metallised and printed. (12:61-67) There is no description that the security indicia of these threads is readable during a detection process, or of a means for preventing interference between a first fluorescing signal emitted by the first indicia and a second fluorescing signal emitted by the second indicia during a detection process for reading information from said first idicia or said second indicia.

Measuring a claimed invention against the standard established by 35 USC 103 requires the critical step of casting the mind back to the time of invention, to consider only the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the art. The case law of the Federal Circuit makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Evidence of a suggestion, teaching or motivation

may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved. The range of sources available, however, does not diminish the requirement for actual evidence. The showing of such actual evidence must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. The required showing of evidence should include particular factual findings. In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed.Cir. 1999).

Here, the rejection is the product of prohibited hindsight reconstruction, using applicants' specification as a blueprint to find an assortment of elements in different references. Because a prima facie case of obviousness has not been established, and the applied references do not teach or suggest the claimed invention, the rejection under Section 103 should be withdrawn.

CONCLUSION

The outstanding objections and rejections have been addressed, and the application is in condition for allowance. Such favorable reconsideration is solicited.

Respectfully submitted,



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